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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,438	01/05/2004	Wolfgang Fitz	2960/118	3735
75059      7590      11/10/2009 Sunstein Kann Murphy & Timbers LLP 125 SUMMER STREET BOSTON, MA 02110-1618				
EXAMINER				
STEWART, JASON-DENNIS NEILKEN				
ART UNIT		PAPER NUMBER		
3738				
MAIL DATE		DELIVERY MODE		
11/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/752,438

**Applicant(s)**

FITZ ET AL.

**Examiner**

JASON-DENNIS STEWART

**Art Unit**

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

The following is a Non-Final Office action in response to communications received on 08/27/09. Claims 1, 27, 28, and 31 have been amended. Claims 47 and 48 have been added. Therefore, claims 1 and 3-48 are currently pending and addressed below.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/27/09 has been entered.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-5, 8, 11-14, 16-26, 28-31, 34-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Carignan et al. 6,712,856.

4. Carignan discloses a replacement device for resurfacing a femur that has joint facing and bone-facing sides. The bone-facing side abuts at least a portion of the femoral condyles and the trochlea (Figs. 3-9). The implant is designed to rebuild a cartilage defect in a patient and to match the uncut femoral bone of a patient with a custom fit. The thickness of the device may vary approximately between 2 mm and 6 mm, depending of the thickness of the patient's original cartilage (col. 7, ll. 9-22). The device is fixed to the distal femur with anchoring pins (Fig. 1). The device is also designed to maintain the "normal kinematics of the joint" i.e. normal joint motion (abstract).

5. Regarding Claims 20 and 21, they do not further limit the structure of the claimed device and, as a result, hold no patentable weight.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 7, 9, 10, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carignan et al. 6,712,856 in view of Fell 2003/0060882.

8. Carignan discloses the invention as claimed and as discussed above. However, Carignan does not disclose an offset thickness.

Fell '882 discloses a metal knee prosthesis (paragraph 74) with biologically active surfaces (paragraph 74) and an offset defined by a ratio (paragraph 28, fig. 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carignan with the offset of Fell '882 in order to restore normal joint alignment without requiring any bone resection as taught by Fell '882 (paragraph 17).

9. Claims 15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carignan et al. 6,712,856 in view of Rolston 2004/016730.

10. Carignan discloses the invention as claimed and as discussed above. However, Carignan does not disclose a second implant component that covers a portion of the patellar surface. Rolston discloses a second component 58 that has a first surface that engages the femur mating surface of the patella and a second surface that engages the patella (fig. 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carignan with the patellar implant of Rolston in order to remedy a patella that is also diseased as taught by Rolston (paragraph 5).

***Response to Arguments***

11. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON-DENNIS STEWART whose telephone number is (571)270-3080. The examiner can normally be reached on M-F (alt Fridays off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571)272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason-Dennis Stewart/  
Examiner, Art Unit 3738

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738